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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,275	03/26/2004	Jayanta Basak	JP920030278US1	2158
7590 Frederick W. Gibb, III McGinn & Gibb, PLLC Suite 304 2568-A Riva Road Annapolis, MD 21401				
06/18/2008				
EXAMINER				
KENNEDY, ADRIAN L				
ART UNIT		PAPER NUMBER		
2129				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,275

Applicant(s)

BASAK ET AL.

Examiner

ADRIAN L. KENNEDY

Art Unit

2129

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Examiner's Detailed Office Action

1. This Office Action is responsive to **Request for Continued Examination**, filed **June 9, 2008**.
2. **Claims 1-2, 4-8, 10-12, and 14-15** will be examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 4-8, 10-12, and 14-15 fail to be tied to another statutory class or transform the underlying subject matter to a different state or thing.

Response to Arguments

Applicant's arguments filed on June 9, 2008 have been fully considered but are found to be non-persuasive. The unpersuasive arguments made by the Applicant are stated below:

In reference to Applicant's argument

Therefore, because independent claims 1, 6, and 7 define "producing a combined classification based upon said overall posterior probability; and outputting said combined classification to classify said vertically partitioned data" it is Applicants position that such claims define patentable subject matter under 35 U.S.C. § 101 and their dependent claims similarly define patentable subject matter.

Examiner's response:

The examiner has considered the applicant's above arguments and in light of a current

interpretations of 35 USC 101, the examiner has determined that "classification" is abstract in nature and does not in fact transform the underlying subject matter to a "different state or thing". This lack of a transformation is due to the fact that classifying only takes preexisting data and separates said data into different classes. This classification inherently does not transform the data into a "different state or thing", due to the fact that if the data changed into "different state or thing", it would have to be reclassified, which would defeat the purpose of classifying in the first place.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vaidya et al. is cited for his privacy-preserving k-means clustering over vertically partitioned data. Kothari et al. is cited for his learning from labeled and unlabeled data.

Examiner's Opinion:

The examiner has considered the applicant's arguments in light of the claimed invention. Furthermore, the examiner respectfully reminds the applicant that **"during examination, the claims must be interpreted as broadly as their terms reasonably allow"**. (MPEP 2111.01 [R-5] I)

It is the goal of the Examiner to move the applicant's claimed invention towards allowability. However, as presently claimed, the applicant's claimed invention is substantially broad and is broad enough to read on the prior art of record. The examiner

respectfully request that the applicant consider what the invention is, and where the line between the prior art (cited by the examiner and/or known by the applicant) and the applicant's intended invention lay. This request is made so the examiner can help the applicant arrive at claim language that not only traverses the language taught in the presently pending and/or previously disclosed prior art, but also traverses concepts taught (or suggested) in prior art known by the examiner and/or applicant which has not been cited. Also, the examiner is more than willing to have an interview with applicant, but requests that the applicant disclose what he or she considers to be the most inventive portion of the claimed and/or disclosed invention.

- Regarding the 101 issues, the examiner has found that the biggest issue with the applicant's claimed invention, is that "classification" has recently been held to be abstract in nature. The claiming of abstract subject matter creates two problems when claimed as a process. The first problem is preemption, due to the fact that the abstract subject matter is not tied to a specific enough subject area, therefore it reads on all possible applications, and the second is non-being a statutory process, because it recites purely mental steps. The second issue is usually resolved in non-process claims which usually recited some form of hardware, computer implementation, and/or medium, however the second is more difficult to solve. In talking with various 101 specialist in the office regarding your specific claimed invention, my understanding is that your invention is not patent eligible because 1) any type of data can be vertically partitioned, 2) there is no specific real world practical application, and 3) it is not clear that the "outputting [of] said combined

classification" is output to the real world.

Should the applicant choose to amend, the Examiner respectfully suggests that the applicant consider including statements along the lines of "a method for classifying vertically partitioned medical data" (or any other specific type of data supported by the specification), "outputting to a display" (or any other type of real world apparatus capable of receiving output and presenting it in a human readable form), "...to classify said vertically partitioned data for maintaining medical data privacy" (or whatever the reason is that the vertical partitioned data is classified). Finally, regarding the term "mutual consistency" (Claims 1, 6, and 7), the examiner asserts that because the term is not a term of art, that it is defined at paragraph 0024 as a "subset C of classifiers [satisfying] Equation [2]". If this assertion is incorrect please indicate that in subsequent correspondence.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian L. Kennedy whose telephone number is (571) 270-1505. The examiner can normally be reached on Mon -Fri 8:30am-5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2129

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALK

/David R Vincent/

Supervisory Patent Examiner, Art Unit 2129